

REMARKS

Claims 1-3 and 5-18 are pending. Claims 1, 3, and 6-14 have been amended. Claims 15-18 have been added. No new matter has been introduced. Reexamination and reconsideration of the application are respectfully requested.

In the September 16, 2008 Office Action, the Examiner rejected claims 6-14 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. In doing so, the Examiner indicated that the term "computer readable recording medium" is not defined. Applicant has amended independent claim 6 in view of the Examiner's comments. Applicant also notes that the specification states:

The host computer 300 is configured by a well-known PC and the like, and comprises writing software for controlling the recording and image forming operations of the optical disc recording apparatus 10 (the software will be described later). A controller 310 is configured by a CPU, a ROM, a RAM, and the like, and, when various control programs stored in the ROM are activated, centrally controls various portions of the host computer 300. (see paragraph 0085)

Accordingly, Applicant believes that claims 6-14 are in compliance with the written description requirement and respectfully requests that the rejection be withdrawn. The Examiner rejected claims 1, 2, 3, and 5-12 under 35 U.S.C. §103(a) as being unpatentable over Maruyama et al., U.S. Patent No. 6,560,407 B2 (hereinafter Maruyama) in view of Anderson et al., U.S. Patent Application Publication No. 20030194214 (hereinafter Anderson) and further in view of Onodera et al., U.S. Patent No. 7,331,055 (hereinafter Onodera). The Examiner rejected claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Maruyama in view of Anderson and Onodera and further in view of Honda et al., U.S. Patent No. 7,015,939 B2. (hereinafter Honda). Applicant respectfully traverses the rejections in view of the claims, as amended.

Independent claim 1, as amended recites:

A method of controlling an operation of an optical disc recording apparatus operable for recording record information onto a recording face of an optical disc and forming an image corresponding to image information on the recording face, the method comprising:

determining both an area of the optical disc at which the record information is to be recorded by the optical disc recording apparatus and an area of the optical disc at which the image corresponding to the image information is to be formed by the optical disc recording apparatus before recording the record information and forming the image;

displaying, on a display, optical disc information reflecting the record information and the image which are determined by the user on the determined areas, respectively, wherein the optical disc information includes a preview display reflecting the determined record information and the determined image; and

giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the displaying step, wherein the record information is recorded on the recording face and the image is sequentially formed on the recording face of the optical disc by applying a laser beam.

The Maruyama reference does not disclose, teach, or suggest the method specified in independent claim 1, as amended. As the Examiner has acknowledged, "Maruyama et al. fails to teach the recording information is recorded and the image is formed on the recording face of the optical disc by applying a laser beam; and displaying preview display which reflecting (sic) the determined record information and the determined image.." (September 16 Office Action, page 4)

In addition, Maruyama fails to disclose "**determining both an area of the optical disc at which the record information is to be recorded by the optical disc recording apparatus and an area of the optical disc at which the image corresponding to the image information is to be formed** by the optical disc recording apparatus before recording the record information and forming the image." Instead, Maruyama discloses that a user determines the recording mode to record data on a DVD wherein data includes recording average bit rate, etc. However, this is not the same as an area of

the optical disc at which the record information and an image are respectively to be recorded.

Maruyama also fails to disclose “giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus *after the displaying step, wherein the record information is recorded on the recording face and the image is sequentially formed on the recording face of the optical disc by applying a laser beam.*”

The Anderson reference does not make up for the deficiencies of Maruyama. The Anderson reference discloses markings representative of a title or filename may be with a laser to either a data side or a label side of an optical disc. However, Anderson makes no mention of “**determining both an area of the optical disc at which the record information is to be recorded by the optical disc recording apparatus and an area of the optical disc at which the image corresponding to the image information is to be formed** by the optical disc recording apparatus before recording the record information and forming the image.” (*hereinafter the “determining limitation”*) Thus, the combination of Maruyama and Anderson fails to disclose, teach, or suggest the determining limitation. The combination of the Maruyama and Anderson also fails to disclose, teach or suggest “giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus *after the displaying step, wherein the record information is recorded on the recording face and the image is sequentially formed on the recording face of the optical disc by applying a laser beam,*”(*hereinafter the “instructing limitation”*) and “*displaying, on a display,*

optical disc information reflecting the record information and the image which are determined by the user on the determined areas, respectively, wherein the optical disc information includes a preview display reflecting the determined record information and the determined image." (*hereinafter the "displaying limitation"*) Accordingly, Applicant respectfully submits that independent claim 1, as amended distinguishes over Maruyama in combination with Anderson.

The Onodera reference does not make up for the deficiencies of Maruyama and Anderson. The Onodera reference discloses that bit map data Dbmp which is stored in a pit art data memory 47 is supplied through a microprocessor MPU to a display section 14, which displays a preview of the manner in which the pit art is to be formed on a program area 2a of a write once disc DSC. (*Onodera, 12:27-42*) However, the combination of Maruyama, Anderson and Onodera fails to disclose, teach or suggest the determining limitation, the instructing limitation and the displaying limitation. Accordingly, Applicant respectfully submits that independent claim 1, as amended distinguishes over Maruyama in combination with Anderson and Onodera.

Independent claims 3, 6, and 15 recite limitations similar to those in independent claim 1, as amended. Accordingly, Applicant respectfully submits that claims 3, 6, and 15 distinguish over Maruyama in combination with Anderson and Onodera for reasons similar to those set forth above with respect to independent claim 1, as amended.

Claims 2, 5, 7-14, and 16-18 depends from independent claims 1, 3, 6, and 15, respectively. Accordingly, Applicant respectfully submits that claims 2, 5, 7-14, and 16-18 distinguish over Maruyama in combination with Anderson and Onodera for the same

reasons set forth above with respect to independent claims 1, 3, 6, and 15, respectively.

With respect to claims 13 and 14, Applicant respectfully submits that the rejection under §103 is improper. Section 103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, *shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.* 35 U.S.C. § 103 (c) (emphasis added)

As indicated above, the Examiner rejected claim 13 and 14 under 35 U.S.C. § 103 (a) as being unpatentable over as being unpatentable over Maruyama in view of Anderson and further in view of Honda et al., U.S. Patent No. 7,015,939 B2. (hereinafter Honda). (*September 16 Office Action, pages 7 and 8*)

However, the Honda reference was “developed by another person” (i.e., Honda is not a named inventor in the present application) and is prior art only under 102(e). Both the Honda reference and the present application are assigned to Yamaha Corporation and thus, are commonly owned. Therefore, in accordance with § 103(c), the Honda reference may not be used to preclude patentability under section 103. Accordingly, Applicant respectfully submits that the rejection of claims 13 and 14 under § 103(a) should be withdrawn.

Applicant notes that the above argument with respect to claims 13 and 14 was previously presented in Applicant’s response dated July 10, 2008, however it appears that the Examiner has not addressed this argument in the September 16 Office Action. Applicants respectfully request that the Examiner acknowledge this argument and include a response to this argument if further action is deemed necessary.

Nevertheless, even assuming *arguendo* that the rejection of claims 13 and 14 under § 103 (a) is proper, the combination of Maruyama, Anderson, Onodera and Honda fails to disclose, teach, or suggest the determining limitation, the instructing limitation and the displaying limitation. Accordingly, Applicant respectfully submits that claims 13 and 14 distinguish over Maruyama in combination with Anderson, Onodera and Honda.

Applicant believes that the foregoing amendment and remarks place the application in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

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